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CONAWAY

January 16, 2023

VIA CM/ECF & HAND DELIVERY

The Honorable Maryellen Noreika
U.S. District Court for the District of Delaware
844 North King Street
Wilmington, DE 19801

Re: PureWick Corporation v. Sage Products, LLC, C.A. No. 22-102-MN

Dear Judge Noreika:

We write to bring the Court's attention to a subsequent case development that is relevant to PureWick's Motion for Judgment on the Pleadings (D.I. 12), which is currently set for hearing on January 20, 2023. Specifically, PureWick's Motion contends that collateral estoppel and res judicata bar Sage from asserting any invalidity and unenforceability defenses for the 376 and 989 patents because, in *PureWick I*, a different Sage product was found to infringe five claims and those five claims were not found anticipated or obvious. (D.I. 13; D.I. 19 at 6-17.)

Since the close of the briefing on PureWick's Motion, PureWick has added a new assertion of alleged infringement of an entirely new independent patent claim against Sage's PrimaFit 2.0 (e.g., Claim 7 of the 989 patent, D.I. 1, Ex. 2) that was never asserted in *PureWick I* and has different scope than any previously-litigated claims. Unlike the claims adjudicated in *PureWick I*, Claim 7 does not require the device to have "a tube" but does recite a "vacuum relief opening." (Compare D.I. 13 at 4 with D.I. 57, Def. Ex. 3 at 10-11; see also D.I. 1, Ex. 2.) Moreover, PureWick has since asserted other claims that were never addressed by the jury. *Id.* As a result, the invalidity and unenforceability of those claims was never previously litigated or adjudicated and estoppel cannot apply or be determined on a motion to dismiss. See, e.g., *Purdue Pharma L.P. v. Mylan Pharms. Inc.*, C.A. No. 15-1155-RGA-SRF, 2017 WL 2569604 (D. Del. June 13, 2017) (denying motion on the pleadings when claims were different). The issue of the new claims was raised during a recent discovery dispute before Magistrate Judge Hall where Judge Hall denied PureWick's motion to preclude third party discovery based on res judicata or estoppel. (See D.I. 62 at 2; Ex. 1, Excerpts of Transcript of 1/6/23 Proceedings at 10, 18, 25 ("we've got at least a new claim")).

Respectfully,

/s/ Anne Shea Gaza

Anne Shea Gaza (No. 4093)

Enclosure (Exhibit 1)

cc: All Counsel of Record (via E-Mail)